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DRUHA
2-9-04

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Appl No. : 09/649,499
Applicant : William F. Jones
Filed : 08/28/2000
TC/A.U. : 2621
Examiner : Tom Y. Lu
Docket No. : 26242.00
Customer No. : 22465

Confirmation No. 8209

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FEB 02 2004

Technology Center 2600

Assignee : CTI PET Systems, Inc.
Title : On-Line Correction of Patient Motion In Three-Dimensional
Positron Emission Tomography
Express Mail : EV 416351178 US

Commissioner for Patents
P. O. Box 1450
Alexandria VA 22313-1450

**SUMMARY OF TELEPHONE COMMUNICATIONS FROM EXAMINER AND LEGAL
INSTRUMENTS EXAMINERS ON JANUARY 22, 23 AND 26, 2004**

Dear Sir:

This Response is filed on behalf of the Applicant in the above-referenced patent application in response to the telephone communications with the Examiner and the Examiner's supervisor on January 22, 2004, the Legal Instruments Examiner (LIE) on January 22, 2004, and the LIE Supervisor on January 23 and 27, 2004. It is deemed to place the application in a condition for allowance.

File History Summary

The Examiner mailed a non-final office action in the above-captioned patent application on July 1, 2004. In the non-final office action, the Examiner indicated certain claims were objected to, but would be allowable if rewritten in independent form to include all of the limitations of the base claim and any intervening claims. A substantive and complete response to the Office Action dated July 1, 2003 was filed on September 28, 2003. In the response, several claims were given the status "Re-presented - formerly claim xx" where "xx" represented the dependent claims to which

the Examiner had objected. This status designation was as proposed in the early stages of the new amendment format requirements.

However, on October 23, 2003, a Notice of Non-Compliant Amendment was mailed indicating that "Each claim has not been provided with the proper status identifier...." Because there were no details given as to which claims were improperly identified, the undersigned called LIE Butler for clarification. The undersigned was instructed to change the status identifier to read "previously presented." A Response was filed which included a replacement section of the **Amendment to the Claims** as required by the Notice.

On January 5, 2004, contrary to the latest instructions received from the PTO, a further Notice of Non-Compliant Amendment was mailed, indicating that the status for the previously subject claims be changed from "previously presented" to "new." Again, a replacement section of the **Amendment to the Claims** was submitted as required.

Communications of January 22, 23 and 27, 2004

On January 22, 2004, the undersigned has been contacted by the Examiner to send via telefax a copy of the remarks and signature of the original response to the Office Action dated July 1, 2003, indicating that he was instructed that the entire document would be entered as "Amendment C." Applicant objected to this requirement, and to the entering of a new amendment.

Applicant's objections were based on the instruction in the Notice of Non-Compliant Amendment (37 CFR 1.121), which sets forth the following introductory paragraph:

The amendment document filed on _____ is considered non-compliant **Only the section (1.121(h)) of the amendment document containing the omission or non-compliant provision must be resubmitted (in its entirety), e.g., the entire "Amendments to the claims" section of applicant's amendment document must be re-sumitted. (emphasis in original)**

In the present situation, the exact situation as used as the example in the instructional paragraph was the exact situation in each Notice received in this case, a copy of each being attached. In accordance with the instructions, Applicant submitted a copy of "[o]nly the section ... of the amendment document containing the ... non-compliant provision...."

In a telephone conversation with LIE Butler, the Applicant's legal representative was informed that it has been the training of the LIEs that the Remarks section of the amendment is to accompany the sections which were subject to the non-compliance. This is contra to the instructions of the Notice and stated above. While it might be argued that the Remarks is not a "section" as set forth in the Notice instructions, such argument would be in contra to 37 CFR 1.121(h), which specifically sets forth the Remarks section as a section. That section reads:

Amendment sections. Each section of an amendment document (e.g., amendment to the claims, amendment to the specification, replacement drawings, **and remarks**) must begin on a separate sheet. (**emphasis added**)

Accordingly, in view of the language of the Notice instructions to submit **[o]nly the section (1.121(h)) of the amendment document containing the omission or non-compliant provision must be resubmitted** and the language of the referenced section 1.121(h) that the remarks section is a separate section, it is respectfully submitted that the instruction purportedly being given to the LIEs is incorrect, and that a replacement Remarks section is not required. Based on the wording of 1.121(h) that each section must begin on a new sheet, and the requirement of the Notice to only submit the sections as set forth above, it is clear to Applicant that the intent is to simply replace those sections not in compliance into the original Amendment as filed, and that the resulting document be entered in response to the Office Action as a complete, fully-responsive, timely-filed and compliant response to the Office Action.

Applicant's legal representative contacted LIE Supervisor Isaac Clark on January 23, 2004 for clarification of the requirements for responding to a Notice of Non-Compliant Amendment. More specifically, Applicant's legal representative inquired as to whether the Remarks section must be submitted with any sections indicated as being deficient or non-compliant. Later that afternoon, LIE Clark left a

voice message indicating that the amendment would be entered without the requirement of any further submissions. Applicant's legal representative returned LIE Clark's call on January 27, 2004, to confirm that the amendment had, in fact, been entered, and further to verify that the Applicant's reading of the Notice and 37 CFR 1.121(h) was correct. Examiner Clark confirmed that the amendment had been entered and that the Applicant's reading of the requirements stated in the Notice and 35 CFR 1.121(h) was correct. Such clarification is appreciated.

In a telephone communication with the Examiner's supervisor, Examiner Boudreau, on January 22, 2004, Examiner Boudreau confirmed that due to the Applicant's *bona fide* efforts in responding to the Office Action and to each of the Notices, a new time period for responding was given with the issuance of each Notice. Namely, as set forth in 37 CFR 1.135(c), when the "reply by the applicant is a *bona fide* attempt to advance the application to final action, and is substantially a complete reply to the non-final Office action, but consideration of some matter or compliance with some requirement has been inadvertently omitted, applicant may be given a new time period for reply under §1.134 to supply the omission." It is respectfully submitted that each of the Response to the Office Action, and each of the Responses to the Notices of Non-Compliant Amendment has been a *bona fide* attempt to advance the present application to a final action. Accordingly, Applicant respectfully submits that each response has been filed within the prescribed time period, and the requirement of any extension fees, nor the abandonment of this application has attached.

Please charge any additional fees associated with this communication, or credit any overpayment, to Deposit Account No. 16-1910.

PITTS AND BRITTIAN, P.C.
P.O. Box 51295
Knoxville, Tennessee 37950-1295
(865) 584-0105 Voice
(865) 584-0104 Fax

Respectfully submitted,
PITTS & BRITTIAN, P.C.

By


Jeffrey N. Cutler
Registration No. 35,486



Paper No. 62

Notice of Non-Compliant Amendment (37 CFR 1.121)

The amendment document filed on 11-21-03 is considered non-compliant because it has failed to meet the requirements of 37 CFR 1.121, as amended on June 30, 2003 (see 68 Fed. Reg. 38611, Jun. 30, 2003). In order for the amendment document to be compliant, correction of the following omission(s) or provision is required. Only the section (1.121(h)) of the amendment document containing the omission or non-compliant provision must be resubmitted (in its entirety), e.g., the entire "Amendments to the claims" section of applicant's amendment document must be re-submitted.

THE FOLLOWING CHECKED (X) ELEMENTS(S) CAUSE THE AMENDMENT DOCUMENT TO BE NON-COMPLIANT:

- ☐ 1. Amendments to the specification:
- ☐ A. Amended paragraph(s) do not include markings.
 - ☐ B. New paragraph(s) should not be underlined.
 - ☐ C. Other _____
- ☐ 2. Abstract:
- ☐ A. Not presented on a separate sheet. 37 CFR 1.72.
 - ☐ B. Other _____
- ☐ 3. Amendments to the drawings: _____
- ☒ 4. Amendments to the claims:
- ☐ A. A complete listing of all of the claims is not present.
 - ☐ B. The listing of claims does not include the text of all claims (incl. withdrawn claims)
 - ☒ C. Each claim has not been provided with the proper status identifier, and as such, the individual status of each claim cannot be identified.
 - ☐ D. The claims of this amendment paper have not been presented in ascending numerical order.
 - ☒ E. Other: Claims 11 & 12 Status should be new

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For further explanation of the amendment format required by 37 CFR 1.121, see MPEP Sec. 714 and the USPTO website at <http://www.uspto.gov/web/offices/pac/dapp/opla/preognotice/officeflyer.pdf>.

If the non-compliant amendment is a **PRELIMINARY AMENDMENT**, applicant is given **ONE MONTH** from the mail date of this letter to supply the corrected section which complies with 37 CFR 1.121. Failure to comply with 37 CFR 1.121 will result in non-entry of the preliminary amendment and examination on the merits will commence without consideration of the proposed changes in the preliminary amendment(s). This notice is not an action under 35 U.S.C. 132, and this **ONE MONTH** time limit is not extendable.

If the non-compliant amendment is a reply to a **NON-FINAL OFFICE ACTION**, and since the amendment appears to be a *bona fide* attempt to be a reply (37 CFR 1.135(c)), applicant is given a **TIME PERIOD** of **ONE MONTH** from the mailing of this notice within which to re-submit the corrected section which complies with 37 CFR 1.121 in order to avoid abandonment. **EXTENSIONS OF THIS TIME PERIOD ARE AVAILABLE UNDER 37 CFR 1.136(a).**

If the amendment is a reply to a **FINAL REJECTION**, this form may be an attachment to an Advisory Action. The period for response to a final rejection continues to run from the date set in the final rejection, and is not affected by the non-compliant status of the amendment.

[Signature]
Legal Instruments Examiner (LIE)
[Handwritten initials]

July 22, 2003 (rev.)



01-29-04

2621

TRANSMITTAL FORM <i>(to be used for all correspondence after initial filing)</i>	Application Number	09/649,499	
	Filing Date	August 28, 2000	
	First Named Inventor	JONES	
	Art Unit	2621	
	Examiner Name	Tom Y. Lu	
Total Number of Pages in This Submission	89	Attorney Docket Number	26242.00

ENCLOSURES (check all that apply)		
<input type="checkbox"/> Fee Transmittal Form <input type="checkbox"/> Fee Attached <input type="checkbox"/> Amendment / Reply <input type="checkbox"/> After Final <input type="checkbox"/> Affidavits/declaration(s) <input type="checkbox"/> Extension of Time Request <input type="checkbox"/> Express Abandonment Request <input type="checkbox"/> Information Disclosure Statement <input type="checkbox"/> Certified Copy of Priority Document(s) <input type="checkbox"/> Response to Missing Parts/ Incomplete Application <input type="checkbox"/> Response to Missing Parts under 37 CFR 1.52 or 1.53	<input type="checkbox"/> Drawing(s) <input type="checkbox"/> Licensing-related Papers <input type="checkbox"/> Petition <input type="checkbox"/> Petition to Convert to a Provisional Application <input type="checkbox"/> Power of Attorney, Revocation Change of Correspondence Address <input type="checkbox"/> Terminal Disclaimer <input type="checkbox"/> Request for Refund <input type="checkbox"/> CD, Number of CD(s) _____	<input type="checkbox"/> After Allowance Communication to Group <input type="checkbox"/> Appeal Communication to Board of Appeals and Interferences <input type="checkbox"/> Appeal Communication to Group (Appeal Notice, Brief, Reply Brief) <input type="checkbox"/> Proprietary Information <input type="checkbox"/> Status Letter <input checked="" type="checkbox"/> Other Enclosure(s) <i>(please identify below):</i> Return Receipt Postcard Communication <i>PTO Office Communications</i>
Remarks		RECEIVED FEB 02 2004 Technology Center 2600

SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT	
Firm or Individual name	Jeffrey N. Cutler
Signature	
Date	01/28/04

CERTIFICATE OF MAILING			
I hereby certify that this correspondence is being facsimile transmitted to the USPTO or deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on the date shown below.			
Typed or printed name	Express Mail Number: EV 416351178 US		
Signature		Date	

This collection of information is required by 37 CFR 1.5. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/649,499	08/28/2000	William F Jones	26242.00	8209
22465	7590	01/05/2004	EXAMINER	
PITTS AND BRITTIAN P C P O BOX 51295 KNOXVILLE, TN 37950-1295			LU, TOM Y	
			ART UNIT	PAPER NUMBER
			2621	lp
DATE MAILED: 01/05/2004				



Please find below and/or attached an Office communication concerning this application or proceeding.

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UNITED STATES DEPARTMENT OF COMMERCE
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/649,499	08/28/2000	William F Jones	26242.00	8209
7590 10/23/2003				
Pitts and Brittian PC PO Box 51295 Knoxville, TN 37950-1295			EXAMINER LU, TOM Y	
			ART UNIT 2621	PAPER NUMBER 4

DATE MAILED: 10/23/2003

CTI, Pet

Please find below and/or attached an Office communication concerning this application or proceeding.

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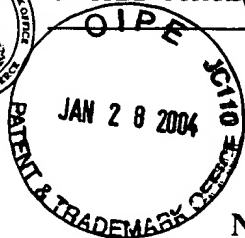
OCT 27 2003

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Paper No. 4

Notice of Non-Compliant Amendment (37 CFR 1.121)

The amendment document filed on 9-28-03 is considered non-compliant because it has failed to meet the requirements of 37 CFR 1.121, as amended on June 30, 2003 (see 68 Fed. Reg. 38611, Jun. 30, 2003). In order for the amendment document to be compliant, correction of the following item(s) is required. **Only the corrected section of the non-compliant amendment document must be resubmitted (in its entirety), e.g., the entire "Amendments to the claims" section of applicant's amendment document must be re-submitted.** 37 CFR 1.121(h).

THE FOLLOWING CHECKED (X) ITEM(S) CAUSE THE AMENDMENT DOCUMENT TO BE NON-COMPLIANT:

- ☐ 1. Amendments to the specification:
- ☐ A. Amended paragraph(s) do not include markings.
 - ☐ B. New paragraph(s) should not be underlined.
 - ☐ C. Other _____
- ☐ 2. Abstract:
- ☐ A. Not presented on a separate sheet. 37 CFR 1.72.
 - ☐ B. Other _____
- ☐ 3. Amendments to the drawings: _____
- ☒ 4. Amendments to the claims:
- ☐ A. A complete listing of all of the claims is not present.
 - ☐ B. The listing of claims does not include the text of all claims (including withdrawn claims)
 - ☒ C. Each claim has not been provided with the proper status identifier, and as such, the individual status of each claim cannot be identified.
 - ☐ D. The claims of this amendment paper have not been presented in ascending numerical order.
 - ☐ E. Other: _____

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For further explanation of the amendment format required by 37 CFR 1.121, see MPEP Sec. 714 and the USPTO website at <http://www.uspto.gov/web/offices/pac/dapp/opla/preognotice/officeflyer.pdf>.

If the non-compliant amendment is a **PRELIMINARY AMENDMENT**, applicant is given **ONE MONTH** from the mail date of this letter to supply the corrected section which complies with 37 CFR 1.121. Failure to comply with 37 CFR 1.121 will result in non-entry of the preliminary amendment and examination on the merits will commence without consideration of the proposed changes in the preliminary amendment(s). This notice is not an action under 35 U.S.C. 132, and this **ONE MONTH** time limit is not extendable.

If the non-compliant amendment is a reply to a **NON-FINAL OFFICE ACTION** (including a submission for an RCE), and since the amendment appears to be a *bona fide* attempt to be a reply (37 CFR 1.135(c)), applicant is given a **TIME PERIOD** of **ONE MONTH** from the mailing of this notice within which to re-submit the corrected section which complies with 37 CFR 1.121 in order to avoid abandonment. **EXTENSIONS OF THIS TIME PERIOD ARE AVAILABLE UNDER 37 CFR 1.136(a).**

If the amendment is a reply to a **FINAL REJECTION**, this form may be an attachment to an Advisory Action. The period for response to a final rejection continues to run from the date set in the final rejection, and is not affected by the non-compliant status of the amendment.

Patricia
Legal Instruments Examiner (LIE)

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